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TOLER SCHAFFER, LLP
8500 BLUFFSTONE COVE
SUITE A201
AUSTIN TX 78759

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OFFICE OF PETITIONS

In re Application of	:	
Chung Yi-Chen	:	
Application No. 10/763,572	:	DECISION ON RENEWED PETITION
Filed: January 23, 2004	:	UNDER 37 C.F.R. § 1.181 AND
Attorney Docket No.: 9182.0005-	:	PETITIONS UNDER 37 C.F.R.
00	:	§§ 1.137(A) AND (B)
Title: INTERPOLATIVE	:	
INTERLEAVING OF VIDEO IMAGES	:	
	:	

This is a decision on the renewed petition filed on August 1, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn, as well as the concurrently filed petitions pursuant to 37 C.F.R. §§ 1.137(a)¹ and (b)², to revive the above-identified application.

¹ A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this

Each of the three petitions will be separately addressed.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed September 21, 2006, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees³. Accordingly, the above-identified application became abandoned on December 22, 2006. A Notice of Abandonment was mailed on January 22, 2007.

An original petition pursuant to 37 C.F.R. § 1.181 was filed on March 8, 2007, and was dismissed via the mailing of a decision on June 7, 2007.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.4(c) sets forth, *in toto*:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order **must** (emphasis added) be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 C.F.R. § 1.36(b) sets forth, *in pertinent part*:

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director.

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- paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.
- 2 A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:
- (1) The reply required to the outstanding Office action or notice, unless previously filed;
 - (2) The petition fee as set forth in § 1.17(m);
 - (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
 - (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

3 See MPEP §710.02(e).

MPEP § 402.06 states, *in pertinent part*:

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. The **withdrawal is effective when approved** (emphasis included) rather than when received.

MPEP § 711.03(c) states, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS OF THE PETITION PURSUANT TO RULE § 1.181

The showing in this renewed petition is not sufficient to withdraw the holding of abandonment. Petitioner has asserted that he failed to receive the Notice of Allowance and Issue Fee Due.

As set forth in the decision on the original petition, the timeline of relevant events is as follows:

- November 22, 2005: a request for withdrawal of power of attorney was filed by the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner LLP (Finnegan). The request further set forth that all future correspondence should be sent to "Jeff Toler, IP Legal Services, 5000 Plaza on the Lake, Suite 265, Austin, Texas, 78746" (IP Legal Services).
- September 8, 2006: a decision was mailed on this request, indicating that the request was not approved. The decision was mailed to the address of record (Finnegan), and a copy was mailed to IP Legal Services.
- September 21, 2006: a Notice of Allowance and Issue Fee Due was mailed to Finnegan.
- January 22, 2007: a Notice of Abandonment was mailed to Finnegan.

In the original petition, Petitioner asserted that the application "is not in fact abandoned" because the Notice of Allowance and Issue Fee Due was not timely received by Petitioner (Jeffrey G. Toler, formerly of IP Legal Services).

The decision on the original petition set forth, *in pertinent part*:

It is further noted in passing that although Finnegan attempted to change the correspondence address to IP Legal Services with the submission of November 22, 2005, this request was improper. Finnegan attempted to file both the request for withdrawal of power of attorney and the change of correspondence address as a single submission. This was improper, pursuant to 37 C.F.R. §1.4(c).

Petitioner has further set forth that he became aware of both the Notice of Allowance and Issue Fee Due and the notice of abandonment upon receiving a letter from Finnegan on February 7, 2007, which included a copy of the Notice of Abandonment. Consequently, he was not aware of the Notice of Allowance and Issue Fee Due until after the expiration of the period for response.

As such, Petitioner has indicated that the Office communication in question was not received by the practitioner. Petitioner has further included a declaration of facts which includes a statement which implies that a search of the file jacket and

docket records indicates that the Office communication was not received (from Finnegan). Finally, Petitioner has included a copy of the docket record where the nonreceived Office communication would have been entered had it been received (from Finnegan) and docketed.

Clearly, Petitioner is attempting to meet the requirements of Delgar v. Schulyer, as delineated in MPEP §711.03(c)(I)(A), reproduced above. However, the Delgar requirements are not relevant to the pertinent case, in that the Office did not mail the relevant communication to Petitioner. In Delgar, the Office mailed a notice of allowance to the applicant, and the Delgar showing provides a mechanism by which applicants can establish that a mailing was not received from the Office. Petitioner is attempting to establish that a mailing was not received from another law firm, a situation which is outside of the scope of Delgar.

Emphasis included.

With this renewed petition, Petitioner has alleged that the Office failed to properly mail the notice. Such is not the case. As set forth in the decision on the original petition, the request to change the correspondence address could not be acted upon, pursuant to Rule § 1.4(c). Finnegan improperly combined the request for withdrawal of power of attorney with the change of correspondence address, and placed each of these distinct matters on the same sheet of paper.

Consequently, the Office properly continued to send correspondence to the official address of record - Finnegan.

Petitioner will note that the decision on the request to withdraw as attorney or agent, mailed on September 8, 2006, explicitly set forth "all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant."

It is noted that a copy of this decision was mailed to Petitioner, and as such, **Petitioner should have been well aware of the fact that the Office had not changed the address of record.**

Petitioner appears to be suggesting that Finnegan failed to promptly notify Petitioner of both the subsequently mailed notice of allowance and issue fee due, and the notice of abandonment. As unfortunate as this alleged failure to communicate may be, this alleged lack of notification from Finnegan does not necessitate the withdrawal of the holding of abandonment.

Petitioner has further asserted that Finnegan's request for withdrawal of power of attorney was not a petition, but rather was a mere letter⁴. Such is not the case. 37 C.F.R. § 1.36(b) sets forth that "a registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record **upon application to and approval by the Director...**" (emphasis added). As such, a petition is required to effectuate the same, and consequently, Finnegan's submission was a petition.

Petitioner has further requested that in the "interest of 'fair administration of the law by the Patent Office,'" the Office should re-mail the notice and set a new period for response. The Office has a well-established and well-publicized procedure by which practitioners may change the correspondence address that is associated with a particular application. Similarly, the Office has a well-established and well-publicized procedure that requires "each distinct subject, inquiry or order" to be "contained in a separate paper." There is nothing that is not "fair" about requiring practitioners to abide by these procedures.

Moreover, the Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions⁵. Specifically, applicant's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133⁶.

Furthermore, the actions of the attorney are imputed to the client, for when an applicant voluntarily chooses an attorney to represent him, the applicant cannot later distance himself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney".

⁴ The relevance of this issue to the question of whether the holding of abandonment should be withdrawn, is not understood.

⁵ Link v. Wabash, 370 U.S. 626, 633-634 (1962).

⁶ Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

⁷ Link at 633-634.

It follows that the petition pursuant to Rule § 1.181 must be dismissed.

ANALYSIS OF THE PETITION PURSUANT TO RULE § 1.137(a)

The relevant standard:

Nonawareness of a PTO rule will not constitute unavoidable delay⁸

The burden of showing the cause of the delay is on the person seeking to revive the application⁹.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."¹⁰

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"¹¹

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action¹².

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other

⁸ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

⁹ Id.

¹⁰ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

¹¹ See In re Mattullah, 38 App. D.C. 497 (D.C. Cir. 1912).

¹² See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present¹³. A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable".¹⁴"

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account"¹⁵.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable".¹⁶"

Analysis:

With the present petition, Petitioner has submitted the issue fee. The fee associated with the filing of this petition has been charged to Petitioner's Deposit Account, as authorized in the petition. Consequently, Petitioner has met requirements (1) and (2) of Rule § 1.137(a). The fourth requirement is not applicable. The third requirement will be discussed below.

As set forth above, Finnegan submitted a request to withdraw as attorney on November 22, 2005, and this request was not granted. The present application became abandoned on December 22, 2006. A Notice of Abandonment was mailed on January 22, 2007. The General Counsel of the Assignee executed a Power of Attorney, revoking all previous powers of attorney and appointing Petitioner. This Revocation and Power of Attorney was submitted pursuant to MPEP § 402.07 to the Office on June 6, 2007, revoking Finnegan's Power of Attorney and appointing Petitioner as attorney of record.

13 In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

14 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

15 Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

16 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

Consequently, Petitioner was not the attorney of record until June 6, 2007. Prior to that time, Finnegan remained the attorney of record.

With the present petition, Petitioner has asserted that the entire period of delay was unavoidable, since Petitioner was not aware of the mailing of the Notice of Allowability and Issue Fee Due. However, the mailing of this notice, the failure to timely respond to the same, the abandonment of the present application, and the mailing of the notice of abandonment are each events which transpired preventable to the appointment of Petitioner as attorney of record. Consequently, the fact that he was not aware of an event during a period that was prior to his appointment as attorney of record cannot give rise to an unavoidable delay.

Moreover, the Revocation and Power of Attorney has been reviewed, and it is clear that it was executed on August 8, 2006. Yet it appears that the document was not submitted to the Office for another 10 months, since the filing was not received until June 6, 2007. Had this document been promptly submitted to the Office, it is highly likely that the paper would have been entered, the address of record would have been changed, and the Notice of Allowance and Issue Fee Due would have been mailed to Petitioner. As such, it appears that the abandonment of the present application could have been avoided by the prompt submission of this filing.

It follows that the petition pursuant to Rule § 1.137(a) must be dismissed.

ANALYSIS OF THE PETITION PURSUANT TO RULE § 1.137(b)

Regarding the third requirement of Rule § 1.137(b)(3), the Rule requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(b)(3); the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.137(b)(3) and Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

The present application went abandoned 6 months before Petitioner became the attorney of record. As such, **it is not apparent that the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.** Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay¹⁷.

Furthermore, it appears that Finnegan, the attorneys of record prior to the abandonment of this application, received a notice of allowance and neither responded to the same nor alerted Petitioner of this requirement. **It will be presumed by the Office that Petitioner has been in contact with Finnegan, and has confirmed that the abandonment was not intentional.**

In the event that these inquiries have not been made, Petitioner must make such an inquiry. If such inquiry results in the discovery that the delay was intentional, Petitioner must notify the Office.

With the present petition, Petitioner has submitted the issue fee. The fee associated with the filing of this petition has been charged to Petitioner's Deposit Account, as authorized in the petition. Petitioner has further included a statement that is being construed as the proper statement of unintentional delay. Consequently, Petitioner has met requirements (1) - (3) of Rule § 1.137(b). The fourth requirement is not applicable.

As such, the petition pursuant to Rule § 1.137(b) is granted.

CONCLUSION

The renewed petition pursuant to Rule § 1.181 is **DISMISSED**.

The petition pursuant to Rule § 1.137(a) is **DISMISSED**.

The petition pursuant to Rule § 1.137(b) is **GRANTED**.

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

¹⁷ See 37 CFR 10.18(b); cf. Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225¹⁸. All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

18 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.